

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFERY M. ENRIGHT, KEVIN F. MARTIN,
BRAD STEPHENSON, ROY HATHAWAY,
TOM KEHNER, CHRISTOPHER J. KNOUFF,
KENNETH C. VARN, JEFFREY R. THOMAS,
JAY PAUL DRUMMOND, JOHN KORTIS,
DAVID A. CRANE, EVAN F. GOLDRING,
ROBERT NOVITSKEY, MICHAEL RUSSELL,
MICHAEL MOTT, CHRIS DIVITA,
AND DOUG WILLIAMS

Appeal 2007-0069
Application 10/603,266
Technology Center 2600

Decided: December 6, 2007

Before KENNETH W. HAIRSTON, JAY P. LUCAS, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

LUCAS, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellants have requested a rehearing of our decision dated May 3, 2007, wherein we affirmed the obviousness rejection of claims 1 and 68 to 89 under 35 U.S.C. § 103.

Appellants present a number of legal and factual issues, which we have considered. We will address the legal issues and then the factual ones.

Legal Issues

Appellants first express concern over the legal standard for review in view of the decision in *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727 (2007). (Reh'g 3.) We have reviewed the detailed rejections that the Appellants have received, especially in the rejection of August 17, 2005 and in the Examiner's Answer of June 19, 2006, and find a detailed application of the cited art references to the claimed subject matter, on a claim-by-claim basis. We do not find error in this regard.

Appellants also expressed concern over a believed misapprehension by the Board of the burden of proof (Reh'g 15). They believed that the Board based its decision on Appellants' arguments, and not a review of the Examiner's rejections. A review of the Decision indicates that a careful review of the rejections of the claims was performed. We found that the Examiner made a prima facie case for the rejection of the claims in the application. Case law indicates that Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. See *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness" (emphasis omitted)) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). We do not find error in the Board's review of the Examiner's rejections, except as will be noted in this response.

Factual Issues

Appellants wrote:

The Board's [sic] relies on Gustin for teaching '*verifying signature...over networks*' and 'an ATM machine with scanned *images* of submitted checks ... plus connections to remote terminals for *transferring the image data*.' The Board's reliance is without basis. Gustin does not teach or suggest using a network to verify a check signature, as relied upon by the Board.

(Reh'g 5, middle).

The passages quoted in the Appellants' text above are taken from page 7, Findings of Fact (FF) 5, of the Board's Decision, which expressed the justification for combining the two references, Gustin and Anderson, by showing that they were addressing the same field of endeavor. The full statement in the Board Decision was, "As the reference Gustin teaches using TIFF images of checks and verifying signature and transaction data over networks (col. 13), and as Anderson addresses the same field of endeavor . . . , we find the rejection based on the two references to be appropriate for rendering the claims obvious (emphasis added)."

On careful review of Gustin, we find that we have slightly misstated the text of that reference (See col. 13, l. 44). Gustin *confirms* rather than *verifies* the signature forwarded to the bank. On reconsideration, the quoted sentence from the Board Decision should have read, “As the reference Gustin teaches using TIFF images of checks and confirming signature and transaction data over networks (col. 13), and as Anderson addresses the same field of endeavor ...” (emphasis added). We thus agree with Appellants that the sentence was in error, but also find that the thrust of the sentence still holds true, that the references are properly combined in the rejection. (See *KSR Int’l v. Teleflex Inc.* cited above.)

Additionally, we amend the Decision by omitting the words “image data” from the Analysis section on page 10, middle, as Gustin teaches scanning an image, but only transmitting the transactional data. The sentence now reads “Gustin discloses an ATM machine with scanned images of submitted checks and other standard ATM features, plus connection to remote terminals for transferring signature and transactional data.” However, the thrust of the paragraph remains intact.

Appellants further contend that the Board erred in its interpretation of Gustin (Reh’g 6, middle). Appellants indicate:

Gustin’s ATM communication is limited to an ATM host. Both Gustin and Anderson use a proprietary bank network for their ATM to ATM host communication. There isn’t any prior art teaching or suggestion of record of using a markup language protocol to communicate between an ATM and its host.

We find this assertion to be in error. We turn to Anderson, and note on Col. 7, line 30+, specific mention of ATMs being connected to user's banks. In col. 32, ll. 57 to 67, we see disclosed the teaching of ATM machines communicating by SGML standards with HTTP servers across the Internet. We find this sufficient teaching to render Appellants' claims of Board error not convincing. The specific arguments Appellants mention of "clearing" checks is not relevant to this teaching, or reflected in the claim limitations.

Appellants contend that the application of Gustin's and Anderson's teachings have not been correctly documented (Reh'g 11, middle). We have reviewed the Examiner's and the Board's decisions, and find a statement of the teachings of the prior art, and the application of the prior art to the claimed subject matter. The resolving of the level of ordinary skill in the art was expressed in the reasons for the rejections, and the maintenance of the rejection. We do not find error in that process.

We do find that claim 73 did not receive individual attention in the Opinion, though it was included in the Decision (Reh'g 12). Claim 73 adds the limitation that the ATM dispenses cash under computer control. We thus amend the Decision by noting that both Anderson and Gustin include in their ATM disclosures the indication that the ATM dispenses cash, as is their well-known function (Gustin, col. 1. l. 9; Anderson, col. 22, bottom). It would be obvious that this feature be included in the prior art teachings as used in the rejection of claim 1.

We have reviewed the other contentions of the Appellants but do not find error in our affirmance of the rejections of the Examiner.

DECISION

The Request for Rehearing is granted with regard to reconsidering the issues raised by the Appellants. The wording of the Opinion is modified as indicated in various paragraphs above. However, the Request is denied with respect to altering the affirmance of the rejections of the Examiner.

REHEARING - DENIED, BUT DECISION AMENDED

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